

501.25507CX5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): O. YOKOMIZO, et al

Serial No.: 08/470,424

Filed: June 6, 1995

For: FUEL ASSEMBLY AND NUCLEAR REACTOR

Group: 2204

Examiner: H. Behrend

Attention: PETITIONS OFFICE

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GROUP 2200

**RENEWED PETITION FOR ISSUANCE OF A COMPLETE OFFICE ACTION
AND NEW REQUIREMENT FOR RESTRICTION**

Assistant Commissioner for Patents
Washington, D.C. 20231

January 7, 1997

Sir:

Petitioners, through their undersigned attorney, respectfully petition the Commissioner of Patents and Trademarks pursuant to 37 CFR §1.181 to require issuance of a new complete Office Action in connection with the above-identified application, wherein claims 24-29 are considered and that a requirement for restriction to which Petitioners are entitled to respond be issued in accordance therewith.

Receipt is acknowledged of the Decision mailed December 31, 1996, in response to the Petition filed July 30, 1996, based upon the Office Action dated July 5, 1996. Petitioners note that due to the delay in issuance of the Decision (five months after the filing of the same), Petitioners were required to file a Response to the Office Action of July 5,

1996, even though Petitioners consider such Office Action to have been incomplete and were required to pay a three month extension of time, even though Petitioners made several telephone calls requesting issuance of a Decision on Petition.

Turning to the Decision mailed December 31, 1996, under the heading "BACKGROUND" and "DECISION", the Group Director at least recognizes that the amendment adding claims 24-29 to the application was present before an action on the merits and therefore was properly before the Examiner prior to an action on the merits.

To review the actions in this application, claims 1-23, as originally presented, were only directed to the apparatus. The Examiner required an election of species in the Office Action dated February 29, 1996, and based upon the election requirement, which was traversed, applicants provisionally elected species I and B. On June 14, 1996, applicants submitted a Supplemental Amendment adding method claims 24-29, pointing out that such claims are readable on the species identified as I and the species identified as B, as previously elected, with traverse, in the Response filed March 29, 1996, and that claims 24-29 should be considered together with the other claims indicated as readable on the elected species.

In the Office Action dated July 5, 1996, the Examiner stated:

Newly submitted claims 24-29 are directed to an invention that is independent or distinct from the invention originally presented and, originally elected in the 3/29/96 response.

The Examiner then pointed out that newly submitted claims 24-29 and the originally presented invention set forth in original claims 1-23, are related as process and apparatus for its practice, referring to MPEP 806.05(e). Thereafter, the Examiner stated:

Accordingly, the apparatus invention of original claims 1-23 has been constructively elected by original presentation of claims as well as by applicants specific election (in the 3/29/96 response) of species I, B of said apparatus claims for prosecution on the merits. Newly submitted claims 24-29 are accordingly withdrawn from further consideration as being drawn to a non-elected invention. See 37 CFR 1.142(b), 37 CFR 1.145 and MPEP 821.03.

Petitioners in the Petition for Complete Office Action filed July 30, 1996, contended that the Examiner had not set forth a restriction requirement in the July 5, 1996 Office Action to which applicants had an opportunity to respond and that the withdrawal of claims 24-29 based upon constructive election was improper and not in accordance with MPEP §821.03, while further referring to MPEP §818.01, which provides "election becomes fixed when the claims in an application have received an action on their merits by the Office." (emphasis added) and MPEP §818.02(a), which provides that "Where claims to another invention are properly added and entered in the case before an action is given, they are treated as original claims for purposes of restriction only. The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant, and

subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP §821.03." (emphasis added).

As is apparent, the first Office Action on the merits in this application was the Office Action of July 5, 1996, which was subsequent to the presentation of claims 24-29 and as recognized by the Decision of the Group Director dated December 31, 1996, "A review of the record indicates that newly submitted claims 24-29 were properly considered...". While this Decision indicates that such claims were found not to be readable on the elected species, there is no statement in the Office Action of July 5, 1996 that the claims are not readable on the elected species, but rather, that the claims 24-29 are directed to a different invention, which is restrictable and therefore, claims 24-29 were withdrawn based upon constructive election. Petitioners submit that such action is not proper. Further, the Decision of December 31, 1996, states:

Applicants' arguments as to what constitutes an Office action in determining claims as "originally" filed for restriction purposes are moot in view of the fact that an election had already been made on March 29, 1996, prior to the submission of claims 24-29. MPEP 809.02(a) is controlling once an election has been made.

Applicants note that MPEP §809.02(a), while setting forth the manner of an election requirement, clearly states:

Such action will not be an "action on the merits"...

However, this portion of the manual also indicates that:

In those applications where requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits... (emphasis added)

It is thus apparent that the election requirement of the Office Action of February 29, 1996, was not an action on the merits and the Office Action of July 5, 1996 was not a proper action since it did not set forth a restriction requirement between original claims 1-23 and claims 24-29 and include an action on all claims present in the application in accordance with MPEP §809.02(a). Rather, such Office Action, prior to an action on the merits which would fix the election, improperly withdrew claims 24-29 based upon a constructive election.

As is apparent, Petitioners have not been afforded due process in accordance with the requirements of the manual and accordingly, the Office Action of July 5, 1996 is improper and incomplete and a new Office Action setting forth a restriction requirement and an election requirement, if deemed appropriate, should be issued.

Furthermore, Petitioners request a refund of the three month extension of time fee in the amount of \$930.00 which was necessitated by the failure of the U.S. Patent and Trademark Office to respond to the Petition filed July 30, 1996, in a meaningful time period.

Favorable action on this Petition is respectfully requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.25507CX5) and please credit any excess fees to such deposit account.

Respectfully submitted,



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